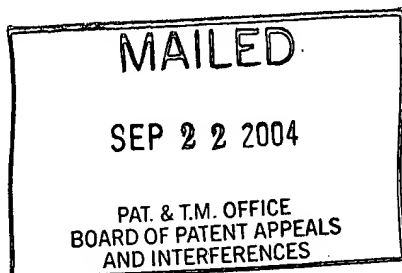




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Sally Gardner Lane  
Telephone: (703) 308-9797  
Facsimile: (703) 305-0942



Applicants: Dryja et al.  
Application No.: 09/387,158  
Filed: 08/31/99  
For: Diagnosis of Retinoblastoma

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,182.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
SALLY GARDNER LANE  
Administrative Patent Judge

Filed by: Sally Gardner Lane  
Administrative Patent Judge  
Mail Stop Interference  
P.O. Box 1450  
Alexandria Va 22313-1450  
Tel: 571-272-9797  
Fax: 571-273-0042<sup>1</sup>

Filed  
22 September 2004

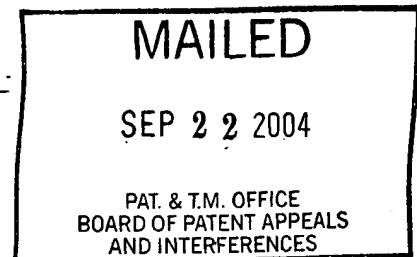
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

WEN-HWA LEE,  
and EVA Y-H.P. LEE  
Junior Party  
(Patent 5,998,134),

v.

THADDEUS P. DRYJA,  
STEPHEN FRIEND, and DAVID W. YANDELL  
Senior Party  
(Application 09/387,158).



Patent Interference No. 105,182

DECLARATION

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count and claims designated as

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<sup>1</sup> The telephone number until October 6, 2004, is 703-308-9797. The facsimile number until October 6, 2004, is 703-305-0942.

corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

The examiner originally proposed the interference on 24 October 2003. On 24 November 2003, the examiner was asked to send the relevant files to the Board. The files arrived on 9 January 2004. On 21 January 2004 a meeting was requested with the examiner to discuss the proposed interference. After multiple communications with the examiner, a meeting was set for 24 March 2004 but the examiner was unable to attend due to illness. The relevant files were returned to the examiner on 14 April 2004 for certain corrections. The examiner returned the files to the Board on 7 September 2004.

**Part B. Judge managing the interference**

Administrative Patent Judge Sally Gardner Lane has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

**Part C. Standing order**

A Trial Section STANDING ORDER [SO] accompanies this DECLARATION. The STANDING ORDER applies to this interference.

**Part D. Initial conference call**

A telephone conference call to discuss the interference is set for **2:00 p.m. on 1 November 2004** (the Board will initiate the call).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. Identification and order of the parties**

Junior Party

Named Inventors: Wen-Hwa Lee  
San Diego, California  
  
Eva Y-H.P. Lee  
San Diego, California

Patent: 5,998,134, based on 08/482,627, filed 7 June 1995

Title: RETINOBLASTOMA GENE-CANCER  
SUPPRESSOR AND REGULATOR

Assignee: The Regents of the University of California

Accorded Benefit: US 07/951,947, filed 28 September 1992  
US 07/108,749, filed 15 October 1987

Senior Party

Named inventors: Thaddeus P. Dryja  
Milton, Maine  
  
Stephen Friend  
Somerville Maine  
  
David W. Yandell  
Waltham, Maine

Application : 09/387,158, filed 31 August 1999

Title: · DIAGNOSIS OF RETINOBLASTOMA

Assignee: None of record

Accorded Benefit: US 08/255,572, filed 8 June 1994

US 07/951,342, filed 25 September 1992

US 07/728,756, filed 8 July 1991

US 07/300,667, filed 23 January 1989

US 07/146,525, filed 21 January 1988

US 06/895,163, filed 11 August 1986

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1). The senior party is responsible for initiating settlement discussions. SO ¶ 18.

## **Part F. Count and claims of the parties**

### Count 1

Claim 1 of Lee (5,998,134) or claim 22 of Dryja (09/387,158).

The claims of the parties are:

Lee: 1-4

Dryja: 22-31, 49, and 50<sup>2</sup>-59

The claims of the parties which correspond to Count 1 are:

Lee: 1-4

Dryja: 22, 23, and 49

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Lee: none

Dryja: 24-31 and 50<sup>3</sup>-59

## **Part G. Heading to be used on papers**

The heading in SO Form 1 must be used on all papers filed in this interference.

See SO ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

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<sup>2</sup> The Form 850 submitted by the examiner does not list a claim 50 as pending in the Dryja involved application. However, a review of the application file and the copy of the claims submitted by the examiner indicates that a claim 50 is pending.

<sup>3</sup> The examiner did not propose a designation for claim 50. However, it would appear that claim 50 should not be designated as corresponding to the count for the same reasons that claim 28, upon which claim 50 depends, is not designated as corresponding to the Count.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Sally Gardner Lane)

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WEN-HWA LEE,  
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Junior Party  
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v.

THADDEUS P. DRYJA,  
STEPHEN FRIEND, and DAVID W. YANDELL  
Senior Party  
(Application 09/387,158).

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Patent Interference No. 105,182

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**Part H. Order form for requesting file copies**

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.



Sally Gardner Lane  
Administrative Patent Judge

Enc:

Copy of STANDING ORDER  
Form PTO-850  
Copy U.S. Patent 5,998,134  
Copy of claims of 09/387,158

Revised September 2004

cc (via overnight delivery):

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